

### **REMARKS**

Pending apparatus Claims 1-14 and 33-55 were rejected as anticipated or obvious. Method Claims 15-32 were previously withdrawn. Dependent Claims 56-60 were added in the Amendment of March, 2003, and were not addressed in the last Office Action.

In view of this Amendment and the comments herein, reconsideration and withdrawal of the rejections are respectfully requested.

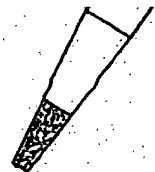
### **PRIOR ARGUMENTS**

The Examiner deemed the Applicant's arguments in the last amendment moot in view of the new grounds of rejection. The Applicant thus withdraws its last arguments.

### **SECTION 102 REJECTIONS ON KOPACIEWICZ**

Claims 1-6, 8-13, 33-39, 43-52 and 54 were rejected as anticipated by Kopaciewicz (6,048,457). But Kopaciewicz forms a single, cast-in-place sorbent which is so large that the cast-in-place material cannot move. Kopaciewicz thus cannot anticipate the claims.

Kopaciewicz (shown here) is titled: "Cast Membrane Structure For Sample Preparations." It describes "a method for casting-in-place composite and/or non-filled structures," which "are cast in-place into a housing such as a pipette tip." Abstract, lines 1-29-10. The cast-in-place casting is formed of "chromatographic beads which have been adhered together with a binder." Col. 4, lines 36-37. A number of suitable adhesive binders are specified (Col. 5, line 62 to Col. 5, line 4. The adhesive binders are so strong they can adhere the casting to the housing as well as bind the beads into a casting. Col. 5, lines 4-10. While the casting can be formed by having individual beads enter the pipette tip, the particles are then held fixedly in place by the adhesive binder to form a single casting formed in place. This solid casting prevents anticipation.



For anticipation every claim element must be found in Kopaciewicz. Independent Claim 35, 46 and 51 each defines a looser media which can flow into **and out of** the opening. The cast-in-place casting cannot flow out of the pipette tip, as it is cast-in-place. The specific claim language is as follows: Claim 35 ("the sorbent material being adapted to pass into and out of the opening with the slurry"); 46 ("the sorbent being sized to pass into and out of the opening with the slurry"); 51

(“the sorbent being adapted to pass into and out of the opening with the slurry”).

Further, Claims 52, 53 and 54 each define a coating “allowing sorbent to be expelled under pressure.” The cast-in-place casting of Kopaciewicz lacks that feature. Similar language is found in independent Claim 1 (“the sorbent material comprising a plurality of sorbent particles which can be separately expelled through the opening in the distal end of the tip during use of the cartridge”); Claim 8 (“the sorbent material comprising a plurality of separately movable particles during use of the cartridge”); Claim 33 (“the sorbent material including a plurality of sorbent particles that can pass in and out of the opening in the distal end during use of the cartridge”).

In view of the above differences, the reconsideration and withdrawal of the rejection on Kopaciewicz is respectfully requested.

#### **THE §103 REJECTION ON KOPACIEWICZ AND MONSOUR**

Claims 7, 14, 40-42, 53 and 55 are rejected under §103 as unpatentable over Kopaciewicz in view of Monsour (6,057,165). Kopaciewicz lacks a “binder” selected from the group of propylene, ethylene glycol or glycerol. Monsour is cited for that deficiency.

These are dependent claims. As Kopaciewicz lacks a claim element, even if it is combined with Monsour the claim requirements are not met. That alone requires withdrawal of the rejection.

While Kopaciewicz refers to a “binder” to adhere the particles to form the cast-in-place casting, the claims do not use that term. Monsour refers to “binding,” but in a very different meaning than in Kopaciewicz. Kopaciewicz uses the “binder” to glue or adhere particles together to form a casting. Monsour refers to chemical binding of an analyte from a test sample for chemical analysis. In the portion cited by the Examiner, Monsour says the binder “is included in the antibody solution to prevent non-specific binding (false positives) during the assay.” Col. 7, lines 54-59.

The binder in Kopaciewicz is critical in that it adheres the particles together to form the casting. There is no showing that the analytic binding of Monsour has any adhesive properties sufficient to adhere particles to form the casting. Likewise, there is no showing that the binder of Kopaciewicz would perform the selective chemical function required in Monsour. Further, there is no showing that particles covered with the glycerol of Monsour would be capable of being cast-in-place by the adhesive binder of Kopaciewicz.

The Examiner must not only explain the motivation for modifying or combining references,

but must point to some concrete evidence in the record supporting the motivation to modify or combine.

As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, **the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.** To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. [In *re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 20010) (emphasis added)].

There is no showing the proffered modifications are desirable, or that they would even would work. The burden needed to establish even a prima facie case of obviousness is not met.

Moreover, here a word with multiple meanings is used differently in two different patents, and then word is used as an excuse to combine those two patents. That “binder” word does not appear in the claims. The Examiner is urged to avoid the insidious temptation to use hindsight to pick and choose isolated portions of the references in order to achieve the claimed combination, and then fabricate a rationale to justify the proffered combination. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”).

Reconsideration and withdrawal of the §103 rejections are respectfully requested.

#### **Other Claim Changes**

Claim 9 is amended to replace “syringe” with the broader term “setter.” Antecedent basis is found in part at ¶ 25 of the specification.

#### **New Claims**

New Claims 61 to 64 are added to further define the solvent.

New Claims 65-67 illustrate further differences over the cast-in-place lump of encased sorbent described in Kopaciewicz. Antecedent basis for the wetting and clumping referred to in the claims is found in part at ¶ 31.

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Attorney Docket No.: MAJOR-062A

**CONCLUSION**

For the above reasons, the amended claims are believed to be in a condition for allowance and such allowance is respectfully requested. If the Examiner has any questions, please contact the undersigned in order to resolve any matters over the phone and to pass the application to issuance.

If any further fees are needed, please charge them to Deposit Account No. 19-4330.

Date: \_\_\_\_\_

12/10/03

Respectfully submitted,

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